UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,914	09/26/2001	Timothy E. Wood	13768.203	9417

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EXAMINER
HUYNH, THU V

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/963,914	WOOD ET AL.
	Examiner	Art Unit	
	Thu V Huynh	2178	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 February 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4,7-9,11,14,16,18,21 and 22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4,7-9,11,14,16,18,21 and 22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: amendment filed on 02/18/2005 to

application filed on 09/26/2001.

2.   Claims 1, 8-9, 11, 16, 18, 21 are amended.

3.   Claims 5-6, 10, 12, 13, 15, 17, 19-20 are canceled.

4.   Claims 1-4, 7-9, 11, 14, 16, 18, and 21-22 are pending in the case. Claim 1 is independent

claim.

5.   The rejections in previous office action are withdrawn in view of the amendment.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

7.   **Claims 11 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is**

directed to non-statutory subject matter.

Regarding independent claims 11 and 21, these claims are not limited to tangible

embodiments. In view of Applicant's disclosure, specification pages 9-10, paragraph [0029], the

media is not limited to tangible embodiments, instead being defined as including both tangible

embodiments (e.g., " RAM, ROM, EEPROM, CD-ROM") and intangible embodiments (e.g.,

"computer-readable media can be any available media"). As such, the claim is not limited to

statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

9.   **Claims 2-4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being**

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding claims 2-4 and 7. These claim recites the limitation of "wherein the specific

act of" renders the claim(s) indefinite, since there is insufficient antecedent basis for this

limitation in the claim.

Regarding claim 7. Claim 7 recites "a method in accordance with claim 6". There is

insufficient antecedent basis for this limitation in the claim, since claim 6 is canceled. Examiner

assumes that claim 7 is dependent on claim 1 for examination purpose.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

> (b) This application currently names joint inventors. In considering patentability of the claims under 35
> U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
> time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
> obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
> owned at the time a later invention was made in order for the examiner to consider the applicability of 35
> U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11.   **Claims 1-3, 8, 11, 14, 18 are rejected under 35 U.S.C. 103(a) as unpatentable over**

Gao et al., US 2002/0032701 A1, priority filed 09/2000, in view of **Homer** et al., "Instant

HTML", copyright 1997, pages 195-201, and **JS-Examples**, "Image sized popup",

http://www.js-examples.com/javascript/?run=638, published 04/2001, pages 1-13, and

Yehuda **Shiran**, "Scriplet Authoring", http://www.webreference.com/js/tips/991222.html,

published 12/1999, pages 1-2.

Regarding independent claim 1, Gao teaches the steps of:

- retrieving the document from the server computer system (Gao, [0032], [0046];

    retrieving the requested HTML document from a server to a client);

- displaying the document on a screen (Gao, [0046]);

- detecting a reference in the document to computer-executable instructions not

    included in the document (Gao, [0046]; detecting a script tag in the HTML document

    that references to a Script source);

- retrieving the computer-executable instructions (Gao, [0048]; retrieving the Script

    program from the server);

- executing the computer-executable instructions to generate a scriptlet (Gao, [0048],

    server generating appropriate JavaScript code);

- detecting an event comprising movement of a cursor within certain boundaries to a

    specific region of the screen (Gao, page 3, [0034]; detecting a pointer or mouse over a

    designated text element in the HTML document, causing a text box to appear).

However, Gao does not explicitly disclose the script is a scriptlet; using a HTML handler

to detect an event; in response to detecting the event, using the HTML handler to pass a

parameter to the scriptlet, informing the scriptlet of the event; using the scriptlet to map the event

to content that is to be retrieved; using the scriptlet to retrieve the content in response to being

informed of the event; using the scriptlet to overlay the content over the displayed document

after retrieving the content.

Homer teaches using a HTML handler to detect an event comprising movement of a

cursor within certain boundaries to a specific region of the screen (Homer, page 195, "Browser

Event Names" section; page 196, "mouseover"; page 199-201).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Homer and Gao to using HTML handler to detect an

event, since the combination would have provided many events and ways to connect the script to

an event as Homer disclosed.

JS-Examples teaches displaying a web page with hyperlinks, such as http://www.js-

example.com/js/pic1.gif, http://www.js-example.com/js/pic2.gif, http://www.js-

example.com/js/pic3.gif (JS-Examples, pages 1-7); clicking one of hyperlink, causing a popup

window overlay on the displayed page (JS-Examples, pages 8) via javascript code (JS-Examples,

pages 11-13), comprising the steps of:

- retrieving and displaying a web page document, wherein the web page contains

    hyperlinks (JS-Examples; pages 1-7);

- in response to detecting the event, using the HTML handler to pass a parameter to the

    scriptlet, informing the script of the event (JS-Examples; pages 8, 11; page 12, lines

    15; page 12, line 40 – page 13, lines 3; when one of these hyperlink is clicked, the

    script function showIt (_v) is executed);

- using the script to map the event to content that is to be retrieved (JS-Examples; page 2, three lines from the bottom; page 4, lines 1-3; when one of hyperlinks is clicked, using script function to map the variables, for example mapping variable "1" from ShowIt(1) to function ShowIt(_v) so that the var_g of "js/pic"+_v"+.gif" becomes js/pic1.gif to be retrieved);

- using the script to retrieve the content in response to being informed of the event (JS-Examples; page 8-10; page 12, line 25; using the script function to retrieve the image js/pic1.gif in function window.open (_g,"",_o), wherein _g is the image js/pic1.gif)

- using the script to overlay the content over the displayed document after retrieving the content (JS-Examples; page 9-10; page 12, line 25; using the script function to display the image js/pic1.gif in a popup window over the displayed document).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined JS-Examples into Gao and Homer to provide a popup window, the combination would have displayed text box or a popup window when moving a display cursor over or clicking on a designated element as Gao disclosed in pargraph [0034].

Shiran teaches, "scriptlet is an independent script that is reference from an HTML page to describe the behavior of an object and the event it is triggered by" as Shiran disclosed in page 1, first paragraph.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Shiran's scriptlet into Gao, Homer and JS-Examples, since the combination would have provided many kind of scripts to provide popup windows when an event is triggered.

Regarding claim 2, which is dependent on claim 1, Gao teaches retrieving document

from the server computer system comprises the following: a specific act of retrieving a

HyperText Markup Language (HTML) document from the server computer system (Gao, page 3,

paragraph 32; page 4, paragraph 46).

Regarding claim 3, which is dependent on claim 2. Gao teaches wherein detecting the

reference in the document to computer-executable instructions not included in the document

comprises the following: a specific act of the detecting a SCRIPT tag in the HTML document

(Gao, page 4, paragraph 46).

Regarding claim 8, which is dependent on claim 1, Gao teaches wherein retrieving the

computer-executable instructions comprises the following: a specific act of retrieving one or

more data structure that represent at least some of the content (Gao, page 3, paragraph 34; page

5; paragraph 50).

Claim 11 is for a computer readable media performing the method of claim 1, and is

rejected under the same rationale.

Regarding claim 14, which is dependent on claim 11, Gao teaches wherein the

computer-readable medium is a physical storage media (Gao, page 3, paragraphs 38-39).

Regarding claim 18, which is dependent on claim 1, the limitation of "wherein the HTML handler is an OnMouseOver handler" is addressed. The rationale is incorporated herein.

12.   **Claims 4, 9, 16, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Gao in view of Homer, JS-Examples and Shiran</u> as applied to claims 1 and 8 above and further in view of <u>Hunt</u> et al., US 2004/0133848 A1, provisional filed 04/2000.** .

Regarding claim 4, which is dependent on claim 1. The combination of Gao, Homer and JS-Examples teaches wherein retrieving the computer-executable instructions comprises the following: a specific act of retrieving computer-executable instructions that operate the overly a window over the displayable form of the document, as explained in claim 1 above. The rationale is incorporated herein.

However Gao does not explicitly disclose overlaying a window over the document *even if other windows or frames already overly the displayable form of the document.*

Hunt teaches, "a popup window may be closed automatically or it may require the user to explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt popup window's modes into Gao to overlaying a window over the document during other windows already overly the displayable form of the document, since the combination would have provided options for display popup windows and the user controls (closes) what popup window as the user wants/needs.

Regarding claim 9, which is dependent on claim 8, Gao does not explicitly teaches wherein the retrieving one or more data structure comprises the following: retrieving one or more data structures that are structured in accordance with the eXtensible Markup Language (XML) format.

Hunt teaches method for providing and displaying information (Hunt's title), using Script to provide popup information for the user in HTML or XML content (Hunt, page 6, paragraph 86; page14, paragraph 177; page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt's XML content into Gao to provide data in XML format, since the combination would have provided both XML or HTML content to be displayed in popup windows for the user.

Regarding claim 16, which is dependent on claim 1, Gao does not explicitly disclose displaying a first window over a portion of the document and displaying a second window over the document during the specific act of displaying the first window over the document.

Hunt teaches, "a popup window may be closed automatically or it may require the user to explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt popup window's modes into Gao to overlaying a window over the document during other windows already overly the displayable form of the document, since the combination would have provided options for display popup windows and the user controls (closes) what popup window as the user wants/needs.

Claim 21 is for a computer readable media performing the method of claim 16, and is

rejected under the same rationale.

Regarding claim 22, which is dependent on claim 21, Gao teaches wherein the

computer-readable medium is a physical storage media (Gao, page 3, paragraphs 38-39).

13.   **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Gao in view</u>**

<u>of Homer, JS-Examples and Shiran</u> as applied to claim 1 above and further in view of

<u>Holbrook</u> et al., US 2002/0152222 A1, provisional filed 11/2000.

Regarding claim 7, which is dependent on claim 1. Gao discloses wherein the retrieving

content in response to the event comprises the following: a specific act of retrieving *update*

information related to the area of the displayable form of the document over which the pointer

has moved (Gao, page 3, paragraph 34; page 5; paragraph 50). Gao does not explicitly disclose

retrieving *help information*.

Holbrook teaches help or any desired information are displayed in a popup window in

response to a mouse over an element of a web page to help the user understands more about the

element (Holbrook, page 6, paragraph 79).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Holbrook and Gao to provide help, update or desired

information that related to the elements in the web page, since the combination would have

provides more information about the elements on primary web pages without cluttering such web

pages.

Response to Arguments

14.   Applicant's arguments with respect to claims 1-4, 7-9, 11, 14, 16, 18, and 21-22 have

been considered but are moot in view of the new ground(s) of rejection.

As discussed in the interview, Gao does not explicitly discloses the step of amended

claims, "using a scriplet to map an event to content to be retrieved and for using the scriptlet to

retrieve the content in response to being informed of the even, such as a cursor movement".

However, the combination of Gao, Homer, JS-Examples and Shiran teaches the amended

claims as explained in the rejection above.

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Durham, US 2002/0054161 A1, filed 06/2001, teaches dynamic site browser.

Green et al., US 2005/0091111 A1, filed 09/2000, teaches network methods for

interactive advertising and direct marketing.

Dino Esposito, "Cutting edge", http://www.microsoft.com/mind/1998/cutting/cuting

1198.asp, published 1998, pages 1-12.

16.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The

examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
May 26, 2005

STEPHEN HONG
SUPERVISORY PATENT EXAMINER